

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte ARIK ELBERSE,
BREANDAN DALTON
and
SEAMUS MACCONAONAIKH

Application 09/707,015

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on September 22, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on December 19, 2005.

37 CFR § 41.37(c)(1)(v) (2005) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 3 and 4 of the Appeal Brief filed December 19, 2005 is deficient because it does not map the independent claims to the specification. Correction is required.

The Appeal Brief is also defective because it is unsigned.

In addition, an Examiner's Answer was mailed on March 21, 2006.

Section 1207.02 of the Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Rev. 3, August 2005) reads as follows:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner is required to include, under appropriate headings, in the order indicated, the following items:

....

(7) *Claims Appendix*. A statement of whether the copy of the appealed claims contained in the appendix to the brief is correct and, if not, a correct copy of any incorrect claim.

(8) *Evidence Relied Upon*. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and in the case of nonpatent references, the relevant page or pages.

The Examiner's Answer is deficient because it does not contain a statement regarding the "Claims Appendix" or the "Evidence Relied Upon." Correction is required.

Finally, the acknowledgment of receipt and entry of a reply brief under 37 C.F.R. § 41.41 is an indication by the examiner that no further response by the examiner is deemed necessary. A Reply Brief was filed under the new rules on May 19, 2006 (§41.41). Section 41.43 reads as follows:

§ 41.43 Examiner's response to reply brief.

- (a)(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.
- (2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.
- (b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.
- (c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications.

In response to the Reply Brief filed May 19, 2006, the Examiner mailed an Office communication which acknowledged receipt and entry of the reply brief but also appeared to include a rebuttal to an issue raised in the Reply Brief. The examiner must follow the guidelines set forth in training

material entitled “Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule,” located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

It should be noted that in accordance with § 41.43, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a Supplemental Examiner’s Answer responding to any new issue raised in the Reply Brief. A Supplemental Examiner’s Answer must be signed by a Technology Center Director. A Supplemental Examiner’s Answer may not include a new ground of rejection. If a Supplemental Examiner’s Answer is furnished by the examiner, the appellants are permitted to file another Reply Brief under § 41.41 within two months from the date of the Supplemental Examiner’s Answer.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellants to submit a signed substitute Appeal Brief which corrects the “Summary of Claimed Subject Matter”;
- 2) for consideration of the substitute Appeal Brief;
- 3) for submission of a revised Examiner’s Answer which includes the “Claims Appendix” and “Evidence Relied Upon” sections;

- 4) for a proper response to the Reply Brief filed May 19, 2006; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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